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HEWLETT-PACKARD COMPANY
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EXAMINER

KALINOWSKI, ALEXANDER G

ART UNIT PAPER NUMBER

3626

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/802,345

Applicant(s)

ALTEN, THOMAS W. VON

Examiner

Alexander Kalinowski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Claims 1-26 are presented for examination. Applicant filed an amendment on 3/7/2005 amending claims 1-3, 10-16, 18-24 and 26. In light of Applicant's amendments and arguments, the Examiner withdraws the 35 USC 101, 35 USC 112 and 35 USC 103 rejection of claims 1-26. However, new grounds of rejection are established in the instant office action based on 35 USC 103. Since the new grounds of rejection were necessitated by Applicant's amendment, the rejection of claims 1-26 is a final rejection of the claims.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 2, 7, 10-11, 15-18 and 20 have been considered but are moot in view of the new ground(s) of rejection.
3. Applicant's arguments filed 3/7/05 have been fully considered but they are not persuasive.

With respect to Applicant's arguments directed to claims 3 and 12, Applicant argues that the Shankland article is a non-enabling disclosure and that the article makes a casual reference to ARS technology. The Examiner disagrees. The Examiner notes that the substance of the article is directed to technology developed by Hewlett Packard specifically with respect to atomic resolution storage. The Examiner notes that Hewlett Packard is the assignee of the instant application. The Examiner notes that subject of the article is directed to Hewlett-Packard's development of ARS technology and fully discloses that this technology allows 10 gigabytes of data to be stored on a compact flash card. This disclosure is more than a passing or casual reference to ARS

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technology. Further, the article describes the assignee's work in ARS technology. The Examiner used the disclosure to teach the limitation of use of ARS technology. Applicant's arguments directed to the use of the Shankland article are deemed nonpersuasive.

Applicant repeats the same arguments with respect to the rejection of claim 21 and the Examiner finds Applicant's arguments non persuasive for the reasons stated for claims 3 and 12.

With respect to Applicant's arguments directed to claims 13 and 14, the Applicant objects to the allegation that Applicant admitted that transferring medical information into a standardized database template is shown. The Examiner notes that Applicant's specification in the specification starts with the sentence "As will be appreciated by persons having ordinary skill in the art, transfer of the collected information into electronic form can be achieved **through several different known methods**" (highlight added). It is because of the phrase "through several different known methods" in this particular section of the specification that the Examiner determined that Applicant was describing techniques that were known in the art (i.e. prior art). It is this phrase that indicates Applicant is describing known techniques or methods or prior art. Use of the phrase "several different known methods" indicates that Applicant incorporated known methods into Applicant's invention. The passage cited (p. 17, lines 2-16 of the specification) describes the technique of using standardized templates for medical information. Therefore, Applicant's arguments directed to the rejection of claims 13 and 14 are non persuasive.

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As to Applicant's arguments directed to claims 23-25, to further compact prosecution of the instant case, the Examiner provides the following reference as evidence to show the Examiner's use of official notice was proper. The Examiner refers Applicant to Mahmud, Pub. No. 2001/0032100. Paragraph 35 discloses the use of passwords (i.e. by either a patient or physician) to access patient medical information. Paragraph 40 discloses that certain users are provided with higher levels of access to patient records than other users. Therefore, Applicant's arguments directed to the use of official notice in claims 23-25 is deemed nonpersuasive and moot.

As to Applicant's arguments directed to claims 8-9, Applicant characterizes the Toronto Star article as a non-enabling disclosure. The Examiner notes that the Toronto Star article describes technology developed by Hewlett Packard which is the assignee in the instant application. The Toronto Star article was used to disclose limitations that were directed to storage capacity and this technology was disclosed in the Toronto Star article. Therefore, Applicant's arguments are deemed non persuasive.

4. Applicant's arguments with respect to the 35 USC 112(1) rejection is persuasive and the Examiner withdraws the 35 USC 112(1) rejection.

5. In view of Applicant amendments to the claims, the Examiner withdraws the rejection of the claims based on 35 USC 112(2) and 35 USC 101.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, 4-7, 10, 11, 15-20, 22, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pat. No. 6,747,561, Reeves in view of Pat. No. 5,557,596, Gibson et al (hereinafter Gibson) and Murray, Bill, "Army brings dog tags into the electronic age"(hereinafter Murray).

As to claim 1, Reeves discloses A personal medical database device, comprising:
a connector for interfacing the database device with a reading/writing device (Fig. 2);
and
at least one memory device contained within the database device, the memory device holding personal medical information of a user of the database device (see Fig. 1 and),
Reeves does not explicitly disclose
wherein the memory device has an increased storage density.

However, Gibson discloses wherein the memory device has a high storage density (see abstract). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation for the motivation of providing a storage device with significantly increased storage density and low cost/ storage (col. 1, lines 53-56).

Reeves and Gibson do not explicitly disclose

Wherein the personal medical database device does not comprise a battery.

However, Murray discloses a personal medical database device does not comprise a battery (i.e. personal information carriers)(page 1). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed by Murray within Reeves and Gibson for the motivation of providing medical information storage devices that have no moving parts and can withstand moisture from perspiration, petroleum and seawater (page 2).

As to claim 2, Reeves, Gibson and Murray disclose The database device of claim 1, wherein the memory device is an ARS device (Gibson, see abstract).

As to claim 4, Reeves, Gibson, and Murray disclose The database device of claim 1, further comprising a controller contained within the database device that communicates with the reading/writing device (Reeves, see Fig. 2).

As to claim 5, Reeves, Gibson, and Murray disclose The database device of claim 1, wherein the database device is sized and configured to be worn on the user's person (Reeves, see abstract).

As to claim 6, Reeves, Gibson and Murray disclose The database device of claim 1, further comprising a water resistant housing that encapsulates the memory device (Reeves, col. 7, lines 45-48).

As to claim 7, Reeves discloses The database device of claim 1, wherein the database device is no larger than approximately 1.75 x 1.5 x 0.125 inches in size (i.e. flash card).

As to claims 10, Reeves discloses A method for creating a personal medical database for a user, comprising the steps of:

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collecting medical information relevant to the user ;

converting the medical information into electronic form (col. 13, lines 7-15); and

writing the medical information to a portable personal medical database device (col. 13, lines 17-24)

Reeves does not explicitly disclose

having at least one memory device having high storage density.

However, Gibson discloses wherein the memory device has a high storage density (see abstract). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed by Gibson within Reeves for the motivation of providing a storage device with significantly increased storage density and low cost/ storage (col. 1, lines 53-56).

Reeves and Gibson do not explicitly disclose

Wherein the personal medical database device does not comprise a battery.

However, Murray discloses a personal medical database device does not comprise a battery (i.e. personal information carriers)(page 1). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation for the motivation of providing medical information storage devices that have no moving parts and can withstand moisture from perspiration, petroleum and seawater (page 2).

As to claim 11, Reeves, Gibson and Murray disclose The method of claim 10, wherein the memory device is an ARS device (Gibson, see abstract).

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As to claim 15, Reeves, Gibson and Murray disclose The method of claim 10, wherein the step of transferring the medical information into electronic form comprises transferring medical history information of the user into electronic form (Reeves, col. 12, lines 25-65).

As to claim 16, Reeves, Gibson, and Murray disclose The method of claim 10, wherein the step of transferring the medical information into electronic form comprises transferring current medical information of the user into electronic form (Reeves, col. 13, lines 62-67).

As to claim 17, Reeves, Gibson and Murray disclose The method of claim 10, wherein the step of transferring the medical information into electronic form comprises transferring textual information relevant to the user into electronic form (Reeves, col. 12, lines 25-65).

As to claim 18, Reeves, Gibson, and Murray disclose The method of claim 10, wherein the step of transferring the medical information into electronic form comprises transferring pictorial information relevant to the user into electronic form (Reeves, col. 12, lines 17-27).

As to claim 19, Reeves, Gibson and Murray disclose a method for carrying a medical storage device as disclosed for claims 1 and 10.

In addition, Reeves, Gibson and Murray disclose presenting the personal medical database device to a medical/dental practitioner prior to receiving medical/dental services (Reeves, col. 13, lines 18-24);

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permitting the practitioner to review and download at least a portion of the medical information stored in the personal medical database device using a computer (Reeves, col. 13, lines 24-27); and receiving medical/dental services from the practitioner (col. 13, lines 46-56).

As to claim 20, Reeves, Gibson, and Murray disclose The method of claim 19, wherein the memory device is an ARS device (Gibson, see abstract).

As to claim 22, Reeves discloses The method of claim 19, wherein the step of carrying the personal medical database device comprises wearing the device on the user's person (see Fig. 1 and abstract).

As to claim 26, Reeves discloses The method of claim 19, further comprising the step of storing new medical/dental information relevant to the medical/dental services received in the personal medical database device after the medical/dental services have been rendered (col. 13, lines 56-67).

8. Claims 3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reeves and Gibson as applied to claims 1 and 10 above, and further in view of Shankland, Stephen, "HP flaunts new tech to raise lab profile (hereinafter Shankland).

As to claims 3 and 12, Reeves and Gibson disclose The database device of claims 1 and 10.

Reeves and Gibson do not explicitly disclose wherein the memory device is an MRAM device.

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However, Shankland discloses wherein the memory device is an MRAM device (page 2).). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed by Shankland within Reeves, Gibson, and Murray for the motivation of using memory that retains information even when power is turned off (page 2).

9. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reeves, Gibson and Murray as applied to claim 19 above, and further in view of Shankland.

As to claim 21, the claim is substantially similar to claims 3 and 12 and is rejected on the same basis.

10. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reeves, Gibson, and Murray as applied to claim 10 above, and further in view of Applicant's admission of the prior art.

As to claim 13, Reeves and Gibson do not explicitly disclose The method of claim 10, wherein the step of transferring the medical information into electronic form comprises entering the information into a standardized database template.

However, Applicant admits that the step of transferring the medical information into electronic form comprises entering the information into a standardized database template was well known in the prior art (see specification, page 17, lines 2-16). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation within the Reeves, Gibson, and Murray combination for the motivation of utilizing readily available off the shelf components in the system to reduce the overall cost of the system.

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As to claim 14, Reeves and Gibson do not explicitly disclose The method of claim 10, wherein the step of transferring the medical information into electronic form comprises electronically scanning the information.

However, Applicant admits that the step of transferring the medical information into electronic form comprises electronically scanning the information was well known in the prior art (see specification, page 17, lines 2-16). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation within the Reeves, Gibson, and Murray combination for the motivation of utilizing readily available off the shelf components in the system to reduce the overall cost of the system.

11. Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reeves, Gibson and Murray as applied to claim 19 above, and further in view of Examiner's use of Official notice.

As to claim 23, Reeves, Gibson and Murray disclose The method of claim 19

Reeves, Gibson and Murray do not explicitly disclose wherein the step of permitting the practitioner to review at least a portion of the medical information comprises the user entering a password/passcode that facilitates access.

However, the Examiner takes official notice that it was well known in the electronic medical records art to provide users with passwords in order to access the medical records in question. The motivation was to provide access to medical records information to those parties authorized by the patient.). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the

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aforementioned limitation within Reeves, Gibson and Murray for the motivation stated above.

As to claim 24, Reeves, Gibson and Murray disclose The method of claim 19, wherein the step of permitting the practitioner to review at least a portion of the medical information comprises the practitioner entering a password/passcode that facilitates access.

However, the Examiner takes official notice that it was well known in the electronic medical records art to provide users with passwords in order to access the medical records in question. The motivation was to provide access to medical records information to those parties authorized by the patient. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation within Reeves, Gibson and Murray for the motivation stated above.

As to claim 25, Reeves discloses The method of claim 24.

Reeves, Gibson and Murray does not explicitly disclose wherein the level of access attained by the practitioner depends upon the password/passcode entered by the practitioner.

However, the Examiner takes official notice that it was well known in the electronic medical records art to provide users with passwords that indicated the selected levels of access to the medical record in order to access the specific medical records in question. The motivation was to provide access only to specified portions of medical records information by those parties authorized by the patient. It would have

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been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation within Reeves, Gibson and Murray for the motivation stated above.

12. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reeves, Gibson, and Murray as applied to claim 1 above, and further in view of Anonymous, "Storage capacity set to make quantum leap" (hereinafter Hewlett-Packard).

As to claim 8, Reeves, Gibson, and Murray disclose The database device of claim 1

Reeves, Gibson, and Murray do not explicitly disclose

wherein the database device has a storage capacity of at least 1 GB.

However, Hewlett-Packard discloses wherein the database device has a storage capacity of at least 1 GB (bottom of page 1 and abstract). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed by Hewlett Packard within Reeves, Gibson, and Murray for the motivation of providing more storage on a tiny compact flash card than available on hard drives of most PC's (see pages 1-2)

As to claim 9, Reeves, Gibson, and Murray disclose The database device of claim 1.

Reeves, Gibson, and Murray do not explicitly disclose

wherein the database device has a storage capacity of at least 5 GB.

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However, Hewlett-Packard discloses wherein the database device has a storage capacity of at least 5 GB (bottom of page 1 and abstract). . It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed by Hewlett Packard within Reeves, Gibson, and Murray for the motivation of providing more storage on a tiny compact flash card than available on hard drives of most PC's (see pages 1-2).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. "Memory cards: designing with a full deck" discloses the use of removable mass storage devices.
- b. "Personal Tag: Product/Applications Background Report" discloses the use of a personal storage device developed in September 1999 for storing comprehensive medical information about a person.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski whose telephone number is (571) 272-6771. The examiner can normally be reached on Monday to Wednesday, 9:00 am to 6:30 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alexander Kalinowski
Primary Examiner
Art Unit 3626

5/29/05